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OFFICE OF PETITIONS

In re Patent No. 6,816,151 :
Issue Date: November 9, 2004 :
Application No. 09/986,591 : DECISION ON PETITION
Filed: November 9, 2001 : UNDER 37 CFR 1.378(b)
Attorney Docket No. TD-101 :
Patentee: Terry Dellinger :
:

This is a decision on the petition under 37 CFR 1.378(b), filed December 29, 2008, to accept an unavoidably delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). **Any such petition for reconsideration must be accompanied by the petition fee of \$400 as set forth in 37 CFR 1.17(f).** The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

The patent issued November 9, 2004. The first maintenance fee could have been paid from November 9, 2007, through May 9, 2008, or with a surcharge during the period from May 10, 2008 through November 9, 2008. Accordingly, the patent expired at midnight November 9, 2008, for failure to timely submit the first maintenance fee.

A petition to accept the delayed payment of a maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1).

This petition lacks item (1) above.

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable". 35 U.S.C. § 41(c)(1).

Petitioner states that the delay in payment of the first maintenance fee was unavoidable since the mailed payment was returned to sender.

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F3d at 608-609, 34 USPQ2D at 1787. It is incumbent upon the patent owner to implement steps to schedule and pay the fee, or obligate another to do so. See California Medical Products v. Technol. Med. Prod., 921 F.Supp 1219, 1259 (D. Del. 1995). That is, 37 CFR 1.378(b)(3) requires a showing of the steps in place to pay the maintenance fee, and the record currently lacks a showing that any steps were emplaced by petitioner or anyone else. In the absence of a showing that petitioner or anyone else was engaged in tracking the maintenance fee due dates, and that party had in fact been tracking the due dates with a reliable tracking system, such as would be used by prudent and careful men in relation to their most important business, petitioner cannot reasonably show that the delay was unavoidable delay. In re Katrapat, 6 USPQ2d 1863, 1867-1868 (Comm'r Pat. 1988); California, supra.

While petitioner acknowledges that he was aware of the maintenance fee due and attempted to pay it, the petition does not indicate that steps were taken to ensure payment of the fee. Here, the payment of the maintenance fee attempted on Monday, November 10, 2008 was mailed to the wrong address even though the correct address was available. The correct address was published as a Notice in the *Official Gazette* of the USPTO on December 25, 2007 and was available since then on the USPTO website, www.uspto.gov. The record does not show how the incorrect address was used despite the exercise of due care. A renewed petition should explain the steps taken to ensure payment of the fee, including the efforts expended in obtaining the mailing address, and how petitioner was "unavoidably" prevented from making the maintenance fee payment.

Petitioner should also note that since the maintenance fee was proffered within 24 months of the date of expiration date of the patent (i.e.: prior to November 9, 2010), he has an alternate remedy under the unintentional provisions of 37 CFR 1.378(c) which does not require a showing of the delay in timely paying the maintenance fee in order to reinstate the patent. This option is available if the delay in payment of the fee due was actually "unintentional" such that payment was not delayed as a result of petitioner's intentional choice to pay other expenses rather than the fee due. In this case, the \$700 already submitted would be applied to the \$1,640 fee owed under 37 CFR 1.378(c), leaving a balance due of \$940. A separate petition for this option may be filed using form PTO/SB/66, which is available at the USPTO website www.uspto.gov.

Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to the Christopher Bottorff at (571) 272-6692.



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